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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,955	02/09/2004	Colleen Zielske	03211	1658

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EXAMINER

AHMAD, NASSER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/775,955

Applicant(s)

ZIELSKE, COLLEEN

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-15 and 17 is/are rejected.
- 7) ☒ Claim(s) 16, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/21/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Colon (4331576).

Colon relates to a label for affixing to a surface comprising a first layer of an adhesive which is water soluble and a second layer which is non-soluble in water, such as plastic film (abstract; col. 2, lines 9-23 and col. 5, lines 3-5). With the adhesive being water soluble, the particles of the adhesive would not be seen by the human eye and that such particle size would be less than 1 mm in size.

The phrases such as “for affixing”, “for engagement”, “may be removed”, “when subjected to water”, etc. are directed to intended future use of the claimed product and has not been given any patentable weight because said phrases are not found to be of positive limitations.

3. Claims 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Dudzik (4444839).

Dudzik relates to a label comprising a first layer of an adhesive which is water soluble, a second layer which is non-soluble in water as it is a plastic film and the adhesive is covered by a release layer (abstract). Since the adhesive is water soluble, the particles

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of the adhesive dispersed in water would not be seen by the human eye and that the particle size would be less than 1 mm in size.

Regarding the intended use phrase as discussed in the preceeding paragraph, it has not been given patentable weight as said phrases are not found to be of positive limitations.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10-13, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Waterbury (2002/0182403).

Waterbury relates to a label comprising a first adhesive layer which is water dissolvable, a second layer of plastic film that is non-soluble in water (abstract and page-2, paragraph-[0022]). Since the adhesive is water dissolvable, the adhesive particles would not be seen by the human eye and the particle size would be less than 1 mm in size. The label can be in a roll form.

As for the intended use phrases, the above explanations apply *a fortiori* herein.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colon in view of Dudzik.

Colon, as discussed above, fails to teach that the adhesive is protected by a release coating. Dudzik, also discussed above, teaches that advantage of using a protective covering over the adhesive layer to protect the adhesive from contamination. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Dudzik's teaching of using a release covering over the adhesive layer in the invention of Colon with the motivation to provide protection to the adhesive layer.

Further, it is well known and conventional in the label art to store the labels in a roll form.

***Allowable Subject Matter***

7. Claims 1-9 are allowed.

The prior art uncovered so far fails to teach a label comprising a layer of water dispersible adhesive, a carrier sheet overlying said adhesive, a layer of pressure sensitive adhesive (PSA) overlying the carrier sheet and a paper or plastic film overlying the PSA, in said order, wherein the paper or plastic film is non-soluble in water.

8. Claims 16, 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art uncovered so far fails to teach a first release coating between the first adhesive and the second layer, with the first release coating requiring greater force for

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removing the first layer from the second layer than the force required to remove the opposite side of the second layer from an adjacent adhesive layer.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad 9/17/05  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
September 17, 2005.